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10/708,566

03/11/2004

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EXAMINER

OBEID, FAHD A

ART UNIT

PAPER NUMBER

3627

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/708,566 | Applicant(s) DELIWALA ET AL. | |
| | Examiner FAHD A. OBEID | Art Unit 3627 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. This is in reply to application filed on 03/24/2009.
2. Claims 1-4 and 6-20 are currently pending.
3. No claims have been added.
4. Claim 5 remain cancelled.
5. Claims 1, 2, 4, 6, 7, 10, 11, 13, 15, and 16 have been amended.
6. Claims 1-4 and 6-20 are currently pending and have been examined.

Specification Objections

7. The amendment filed 03/24/2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: “providing said unique identifiers to the provider”.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's amendment filed on 03/24/2009 contains the limitation "providing said unique identifiers to the provider" is considered new matter since it does not have any support in the specification. The applicant specification discloses the following "while the various jobs performed by the computing provider are assigned a unique identifier, those unique identifiers are not otherwise used by the computing provider, which only provides a bill for the total services provided" (para 41); also "the user may submit a corporate account number or a project number such that the computing time is billed to the corporation, but a portion of the time is billed to the specific project being completed by the corporation" (para 46). Therefore, the provider provides a total bill to a corporation account number, while the corporation allocates the bill to the users corresponding to the unique identifiers.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-4, and 6-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacFarlane (US 6,125,354) in view of Peterson (US 7,020,628).

13. Regarding Claim 1: MacFarlane discloses a method for facilitating the allocation of a billing incurred by an entity from a technology resource provider, said method comprising:

- Associating unique identifiers with technology resources of the provider, said unique identifiers being associated by the entity (fig.5 and col 6 lns 61-64);
- receiving a business model (organization hierarchy) file corresponding to an internal structure of the entity, the business model file including (col 1 lns 27-42 and col 3 lns 54-63) at least one application profile (col 4 lns 6-8);
- associating at least one of said unique identifiers with at least one user within the entity (fig.5 and col 6 lns 61-64);
- receiving said billing, which includes data corresponding to usage of at least one of said technology resources by the entity and data corresponding to said unique identifiers (col 6 lns 17-20 and col 8 lns 49-58).

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- allocating respective portions of said billing based on said business model file, said portions corresponding to usage of said technology resources by the at least one user (col 2 lns 58-67, col 6 lns 57-59, and col 9 lns 25-35).

MacFarlane does not explicitly disclose providing unique identifiers to the provider.

However, Peterson does disclose providing unique identifiers to the provider (col 4 lns 21-60)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the host computer or computer network of the company, in addition to tracking the usage of computer time and various costs associated with that time (Peterson; col 1 lns 27-30).

14. Regarding Claim 3: MacFarlane discloses a method of claim 1, wherein receiving said business model file further includes receiving said business model file at a controller (figs 1-4, col 1 lns 27-42, and col 3 lns 54-63).

15. Regarding Claim 4: MacFarlane discloses a method of claim 1, further including automatically recognizing the at least one user (figs. 2-4 and col 8 lns 26-34).

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16. Regarding Claim 6: MacFarlane discloses a method of claim 1, wherein said allocating further includes allocating loyalty points to the at least one user (figs. 2-4 and col 8 lns 26-34).

17. Regarding Claim 7: MacFarlane discloses a method of claim 1, wherein said allocating further includes reducing said billing by a monetary value of loyalty points (figs. 2-4 and col 8 lns 26-34).

18. Regarding Claim 8: MacFarlane discloses a method of claim 1, wherein said allocating further includes at least one of transferring, pooling and gifting loyalty points (figs. 2-4 and col 8 lns 26-28).

19. Regarding Claim 9: MacFarlane discloses a method of claim 1, further including providing a descriptive billing statement including at least a portion of said business model file (fig.1, col 4 lns 45-48, and col 7 lns 10-14).

20. Regarding Claim 11: MacFarlane discloses a method of claim 1, further including adjusting said billing based upon at least one of a CPU-second used, a total CPU-seconds expected to be used, a volume discount, a stepped-type of pricing, a peak/off-peak usage, a geographic location, a service provided, a performance expectation, a location, a service level scoring, a CPU cycle, a local power consumption cost, a physical site security, an increased site security, an additional operational procedure needed to support increased sensitive data, a level of fail over needed, a service level agreement, and an account data privacy requirement (figs 2-4,

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abstract, and claim 1).

21. Regarding Claim 12: MacFarlane discloses a method of claim 1, further comprising: determining said internal structure, including various groups and sub-groups within said entity (col 1 lns 27-35); determining a billing detail of said group within said entity (fig.1, col 4 lns 45-48, and col 7 lns 10-14); determining a value driver of said entity (claim 1); and determining an application profile of said entity (col 4 lns 6-8).

22. Regarding Claim 17: MacFarlane discloses a method of claim 13, further including performing data analysis of said computer usage using the at least one application performance driver (fig.1, col 5 lns 1-12, and claim 4).

23. Regarding Claim 18: MacFarlane discloses a method of claim 13, further including suggesting a cost efficient usage practice (col 1 lns 42-46 and col 1 lns 61-65).

24. Regarding Claim 19: MacFarlane discloses a method of claim 13, further including requesting a bid based upon said monitoring step (col 3 lns 31-40).

25. Regarding Claim 20: MacFarlane discloses a method of claim 1, wherein said business model file further includes at least one of an application profile, a value driver, a user level, a geographic area, a project, a zone, a third party provider, loyalty information and a rule (col 3 lns 31-40 and col 4 lns 1-8).

26. Regarding Claims 2, 10, and 13-16: MacFarlane does not explicitly disclose a computer usage includes computing time obtained from an outsourced provider, monitoring computer usage, and notifying at least one user of said computer usage.

However, Peterson does disclose a method of claim 1 wherein said technology resources includes at least one of computer usage, wherein said computer usage includes computing time obtained from an outsourced provider, telephony resource usage, manufacturing cycles and production runs (col 1 lns 17-18 and col 4 lns 7-10); Monitoring said computer usage (col 1 lns 46-50); notifying the at least one user of said computer usage (col 5 lns 10-15).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Peterson's teachings in MacFarlane's "system and method for generating an invoice charges to the elements of an organization" enabled, for the advantage of monitoring the costs of remote users accessing the computer of the company (Peterson; col 1 lns 27-29).

Response to Arguments

27. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

28. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FAHD A. OBEID whose telephone number is (571)270-3324. The examiner can normally be reached on Monday to Friday 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ryan Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Fahd A Obeid/
Examiner, Art Unit 3627
June 14, 2009

/F. Ryan Zeender/
Supervisory Patent Examiner, Art Unit 3627